PARFUMS ROCHAS,	)	INTER PARTES CASE NO. 1890
Opposer,	)	
	)	OPPOSITION TO:
	)	
	)	Serial No. 42467
- versus -	)	Filed : September 8, 1980
	)	Trademark : "GENUINE ROCHA"
	)	Used on : Textile materials
	)	
	)	DECISION NO. 94-29 (TM)
CHARLES CHIU UY,	)	
Respondent-Applicant.	)	April 19, 1994

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DECISION

This is an Opposition filed by Opposer PARFUMS ROCHAS, a corporation organized under the laws of France with business address at 33, Rue Francois ler, Paris, 8e, France against trademark application bearing Serial No. 42467 filed on September 8, 1980 by CHARLES CHIU UY, a Filipino citizen, with address at Pasilio A. No. 526 Gen. Shopping Center, Manila for the trademark "GENUINE ROCHAS" used on textile materials which application was published on page 28 of the Official Gazette, Volume 80, No. 22 dated May 28, 1984 and officially released on October 19, 1984.

The grounds of opposition are as follows:

"1. The opposer is the owner-registrant and has been using the trademark "PARFUMS ROCHAS" in trade and in commerce in the Philippines, for perfumery, beauty products, essential oils, cosmetics, hair lotions and toilet soaps under Class 3 of the International Classification of Goods and Services long prior to that of Respondent-Applicant, said trademark "PARFUMS ROCHAS" is covered by Certificate of Registration No. 10209, dated 19 June 1973;

2. The mark "PARFUMS ROCHAS" which the opposer has created and adopted is well known in the Philippines and throughout the world and has an excellent reputation because of the high quality of the products bearing the said mark.

3. The mark "PARFUMS ROCHAS" is likewise a tradename of the opposer.

4. The application subject of this opposition was filed only on September 8, 1980 and respondent-applicant claims first use of the mark "GENUINE ROCHA" in trade and in commerce in the Philippines only on January 2, 1978.

5. Applicant's alleged mark "GENUINE ROCHA" is confusingly similar to opposer's trademark "PARFUMS ROCHAS" and the registration of the applicant's alleged mark would violate opposer's rights and interests in its trademark "PARFUMS ROCHAS". Moreover, confusion between opposer's and applicant's respective business and products as well as the dilution and loss of distinctiveness of opposer's trademark is inevitable."

The Respondent filed his answer on the 10th of September 1995 denying all the material allegations therein and interposed the following as his special and affirmative defenses:

"1. Since applicant's mark is registered with the Supplemental Register (Regn. No. 5128, Nov. 12, 1980), opposition proceedings is not the proper remedy;

2. Even on the assumption that opposition is the proper remedy, still the instant opposition will not lie because it has been filed out of time;

3. The opposer has no cause of action because the applicant's mark is not likely to cause confusion as opposer's product line is completely different from that of applicant, and the wordings of the two marks are different from one another and will not mislead the ordinary buyer; even the design of the marks are different."

Pre-Trial Conferences were conducted but the parties failed to reach an amicable settlement for which trial on the merits ensued.

After opposer has presented its evidence consisting of Exhibits "A" to "J" including its sub-markings and that no comments/objections were filed therein by Respondent-Applicant, a Notice for hearing of Respondent-Applicant's reception of evidence was issued (ORDER NO. 88-16) dated January 19, 1988.

Two years hence, Respondent-Applicant failed to present his evidence and upon oral motion in open court by opposer, Respondent-Applicant has been considered to have waived his right to present his evidence (ORDER NO. 90-51) dated February 5, 1990.

The issue to be resolved is whether or not Respondent's trademark "GENUINE ROCHA" is confusingly similar to Opposer's trademark "PARFUMS ROCHAS" and "ROCHAS"

In resolving questions of confusingly similarity of trademarks, the law does not require that the competing marks be so identical as to produce actual error or mistake; it would be sufficient for the purpose of the law that similarity between two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the new brand for it (American Wire Cable vs. Director of Patents, 31 SCRA 544). That is, if there is similarity in the dominant features of the competing marks there may be a likelihood of confusion (Phil. Nut Industry vs. Standard Brands, 65 SCRA 575).

In the case at bar, the dominant words are "ROCHAS" for the opposer since PARFUMS is a noun; and "ROCHA" for the Respondent since GENUINE is an adjective.

Note should be taken that opposer registered ROCHAS in France under trademark Registration No. 732774 as early as 18 January 1968 for goods falling under International Classes 1 to 34 (Exhibit "E-4").

The ordinary customer does not scrutinize the details of the labels; he forgets or overlooks these, but retains a general impression, or a central figure, or a dominant characteristic, hence, notwithstanding the fact that the accessories or background of the competing marks a re dissimilar, the word "ROCHAS" alone used by different manufacturers/merchants creates confusion or deception on the minds of the ordinary purchaser.

Respondent-Applicant may not appropriate Opposer's trademark and avoid likelihood of confusion by adding the word "GENUINE" thereto. Thus, in Continental Connector Corp. vs. Continental Specialties Corp., 207 USPQ 60, it has been ruled that "Courts have repeatedly held that the confusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term."

As to the goods in connection with which the competing marks are sued, it is noted that the mark of the Respondent-Applicant is used on textile materials which are among the classes

of goods covered by the Opposer's registration of the mark in France (supra). There is therefore a likelihood that the opposer, if it is not yet using PARFUMS ROCHAS in connection with textile materials in the Philippines would do so sometime in the future.

The conclusion may therefore be drawn that "perfumery, beauty products, essential oils, cosmetics, hair lotions and toiler soaps", the goods in connection with which PARFUMS ROCHAS is used, and textile materials, GENUINE ROCHAS' specification of goods, are related in that the latter is within the zone of natural expansion of the other. The court in finding that the trademarks T.M. X-7, and X-7 are confusingly similar notwithstanding the fact that their respective goods fall under different categories reasoned that the making of laundry soap is but a natural expansion of the business dealing in perfume, lipstick and nail polish. (Chua Che v Philippine Patent Office, L-18337, Jan. 30 1965, 13 SCRA 67) The same ruling was made by the court with respect to shoes and slippers vis-à-vis pants and shirts (Ang Teodoro, ibid., p.93) and between haberdashery and shoe making. (Sta. Ana v Maliwat, L-23023, Aug. 31, 1968, 24 SCRA 1018)

Based on the records and evidence submitted, Opposer's mark has been continuously sold commercially in the Philippines as early as 19 June 1973 while the Respondent-Applicant could claim first use of his mark "GENUINE ROCHA" much later on 3 September 1980, the filing date of his application there being no other evidence to substantiate his claim of first use of the mark in the Philippines. This is in accordance with Rule 173 of the Revised Rules of Practice in Trademark Cases, viz:

> "*RULE 173. Allegations in the application not evidence on behalf of the applicant.* - - In all inter partes proceedings, the allegations of date of use in the application for registration of the applicant or of the regrant cannot be used as evidence in behalf of the party making the same. In case no testimony is taken as to the date of use, the party will be limited to the filing date of the application as the date of his first use."

WHEREFORE, premises considered this opposition is hereby SUSTAINED and application Serial No. 42467 for the trademark "GENUINE ROCHA" filed by Charles Chiu Uy on September 8, 1980 should be, as it is hereby REJECTED.

Let the filewrapper of this case be forwarded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision. Likewise, let a copy of this Decision be furnished the Trademark Examining Division for information and to update its records.

SO ORDERED.

IGNACIO S. SAPALO
Director